

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/561,823

Applicant(s)

HANSEN ET AL.

Examiner

Michele K. Joike

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: PTO-892 form attached.

/Michele K. Joike/
Primary Examiner, Art Unit 1636

Cont. of 8. The declaration filed under 37 C.F.R. 1.132 is not being entered. Furthermore, it is unclear who Professor Birger Lindberg Moller is. In the declaration, he declares himself to be an owner of the invention, however, there is no record of this. He is also not listed as an inventor in the application.

Cont. of 11. The declaration is not entered, and therefore is not considered. Additionally, Applicant's remarks that are tied to the declaration are not being considered. However, Applicants have separately argued that it is clear that claim 1 specifically claims the dual biosynthesis pathways for both vanillin and the glycosyltransferase within a yeast microorganism yielding production of vanillin and glycosylated vanillin. Applicants also dispute the statement by the Examiner in the previous office action that "there is reason to believe that glycosylating other aglycons will be successful."

Applicant's arguments are not found to be persuasive for the following reasons. Moehs et al teach the introduction of SGT into a yeast cell for the production of a glycosylated aglycon. They also teach adding the aglycon to the media in order to be glycosylated. They do not teach that the cell has a gene encoding a product involved in the biosynthesis pathway leading to the aglycon. However, Priefert et al teach the production of vanillin, wherein the cell comprises a gene encoding a product involved in the biosynthesis pathway leading to the aglycon. For example, *Pseudomonas* strain HR199 has genes leading to the production of vanillin. (This is taught by Priefert et al, however, reference Overhage et al is provided as further evidence.) Therefore, one of skill in the art would know that vanillin biosynthetic genes could be used in a microorganism, as opposed to merely supplementing the media with the aglycon. Combined with Day et al and Arend et al, the references teach the claimed invention. Furthermore, as argued previously by the Examiner, claim 1 does not claim the vanillin biosynthetic pathway, but a method for producing vanillin, wherein a gene involved in the biosynthesis is present. In response to the statement that "there is reason to believe that glycosylating other aglycons will be successful", the Examiner still believes there is a reasonable expectation of success for glycosylating aglycons, as Arend et al teaches the glycosylation of vanillin, and other aglycons.